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Application Number	09/258,216
Filing Date	26 February 1999
First Named Inventor	SODERLUND, Hans E.
Art Unit	1634
Examiner Name	SITTON, Jehanne Souaya
Attorney Docket Number	13025-5

Total Number of Pages in This Submission

ENCLOSURES (Check all that apply)

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Amendment under 37 CFR 1.121
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	J. David Ellett, Jr.
Signature	
Date	5 May 2004

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1634

Patent
62616.1

Attorney Docket 13025-5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Applicants: SODERLUND, Hans E. and)	
SYVANEN, Anne-Christine)	Examiner: SITTON, Jehanne Souaya
)	
Serial No.: 09/258,216)	Group Art Unit: 1634
)	
Filed: 26 February 1999)	
)	
For: "Method and Reagent for Determining)	
Specific Nucleotide Variations ")	

Kalow & Springut LLP
488 Madison Avenue, 19th Floor
New York, New York 10022

5 May 2004

Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

**REPLY TO A NOTICE OF NON-COMPLIANT
AMENDMENT UNDER 37 CFR 1.121**

SIR or MADAM:

This is in reply to a notice of non-compliant amendment issued on 5 April 2004 with respect to a reply to an office action filed on 1 April 2004 with a request for continued examination (RCE) in connection with the patent application identified above. The present reply

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5 May 2004
Date

J. David Ellett, Jr.
J. David Ellett, Jr. (Reg. No. 27,875)

Applicants: Soderlund, Hans E., and Syvanen, Anne-Christine
Filing Date: 26 February 1999
Serial No.: 09/258,216
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is being submitted to the Patent and Trademark Office by mail with a certificate of mailing on 5 May 2004, the day set for a reply.

In the outstanding notice of non-compliant amendment, it was asserted that the reply of 1 April 2004 failed to meet certain requirements of 37 CFR 1.121. In particular, it was asserted that the amendments to the claims in the reply of 11 March 2004 did not include a complete listing of all of the claims. The notice of non-compliant amendment required that only corrected sections of the assertedly non-compliant amendment document be resubmitted in their entirety.

The attorneys for the applicants respectfully submit that the amendments to the claims in the reply of 1 April 2004 fully complied with 37 CFR 1.121. In particular, 37 CFR 1.121(c) specifies that “[e]ach amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application.” [Underlining added.] As pointed out in the section of the reply of 1 April 2004 involving amendments to the claims of the subject application, the subject application was a continued prosecution application (CPA) which was filed on 26 September 2002. The listing of claims in the section of the reply of 1 April 2004 involving amendments to the claims was an accurate listing of all the claims of the subject continued prosecution application filed on 26 September 2002.

In a telephone conference with the undersigned attorney on 1 April 2004 in connection with a notice of non-compliant amendment issued with respect to related application 08/466,322, attorney Robert J. Spar of the Office of Patent Legal Administration of the Patent and Trademark Office indicated that, notwithstanding the language in 37 CFR 1.121(c) calling for a complete listing of all claims “in the application” and the fact that a continued prosecution application (CPA) is a separate application from the parent application on which the continued prosecution application is based, the Patent and Trademark Office expected a continued prosecution

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application and its immediate parent application to be treated as a single application for purposes of compliance with the requirements of 37 CFR 1.121(c).

Although the attorneys for the applicants maintain that the claim listing in the amendments-to-the-claims section of the reply of 1 April 2004 was fully compliant with the express wording of 37 CFR 1.121(c) and that the objections to the reply set out in the notice of non-compliant amendment of 5 April 2004 were without merit, to expedite prosecution of the subject application, an alternative amendments-to-the-claims section for the reply of 1 April 2004 is set out below which ignores the distinction between the subject continued prosecution application (CPA) filed 26 September 2002 and its immediate parent application of the same application number filed on 26 February 1999.

Authorization is hereby given to the Patent and Trademark Office to enter in the file of the subject application, at the Office's election, the alternative amendments-to-the-claims section for the reply of 1 April 2004 set out below which ignores the distinction between the subject continued prosecution application (CPA) and its immediate parent as a replacement for the amendments-to-the-claims section of the reply of 1 April 2004 as originally filed which, it is respectfully submitted, properly took account of the distinction between the subject continued prosecution application and its immediate parent.